

APR 30 2004

OFFICIAL

Serial No 09/714,018
In reply to Office Action mailed September 25, 2003
and Office Action mailed March 2, 2004
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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of:

Harry Thomas Kloor

Ser. #: 09/714,018

Filed: November 16, 2000

For: DUAL TRANSACTION
AUTHORIZATION SYSTEM
AND METHOD

Examiner: James S. McClellan

Art Unit: 3627

Atty. Docket #: 18822/11

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

I certify that this paper is being transmitted via facsimile
to Examiner James McClellan at the U.S. Patent and
Trademark Office at facsimile number 703-872-9306 on
April 30, 2004 (37 CFR 1.8a).

Ann Pommier
Ann Pommier

RESPONSE TO ELECTION REQUIREMENT

Dear Sir:

In the present application, Office Actions were mailed on September 25, 2003 and March 2, 2004, which included an election requirement under 35 U.S.C. § 121. Examiner alleged that the application contains claims directed towards patentably distinct species as follows:

Group A – Authorization Channel

- A1: Internet (for example, claims 2-3)
- A2: Telephone (for example, claim 4)
- A3: Wireless (for example, claim 5)

Group B – Personal Communication Device

- B1: Cellular Phone (for example, claim 13)
- B2: Personal Digital Assistant (for example, claim 14)

Group C – Check Identification Feature

- C1: Barcode (for example, claim 48)
- C2: Magnetic Strip (for example, claim 49)
- C3: DIGIMARC (for example, claim 50)

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(a) *Election*

Examiner requires that Applicant elect a single species from each of the identified Groups for prosecution on the merits. In response to this requirement, Applicant provisionally elects as follows: as to Group A, Applicant provisionally elects the Internet with traverse; as to Group B, Applicant provisionally elects Cellular Phone with traverse; and as to Group C, Applicant provisionally elects Barcode with traverse.

In accordance with the requirement to list all claims readable on the provisionally elected species, claims 2 and 3 read on an authorization channel through the Internet, claim 13 reads on a personal communication device that is a Cellular Phone, and Claim 48 reads on a check having a Bar Code. Additionally, claims 1 and 6-62 are generic to an authorization channel through the Internet, claims 1-12 and 15-62 are generic to a personal communication device that is a Cellular Phone, and claims 1-47 and 51-62 are generic to a check having a Bar Code.

(b) *Traversal*

Applicant traverses the election requirement for Group A for at least the reason that the alleged species identified are not restricted to mutually exclusive characteristics. Specifically, MPEP § 806.04(f) requires that "claims to be restricted to different species must recite the mutually exclusive characteristics of such species." However, Applicant asserts that an authorization channel through the Internet, which is recited in claims 2-3, is not mutually exclusive of an authorization channel using a Telephone Line, which is recited in claim 4. For instance, where an authorization channel includes a modem, which accesses a telephone line, to connect to the Internet, the authorization channel includes both the Internet and a Telephone Line. *See, also*, Specification, page 5, lines 10-28, page 9, lines 21-25 (describing connecting to the Internet through a modem). Similarly, Applicant asserts that an authorization channel through the Internet is not mutually exclusive of an authorization channel using a Wireless System, which is recited in claim 5. For instance, where an authorization channel includes a Wireless System that connects to the Internet, the authorization channel includes both the Internet and a Wireless System. *See, also*, Specification, page 14, line 23—page 15, line 13 (describing the use of a wireless communication device, such as a PDA or cell phone, to connect to the Internet).

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Applicant traverses the election requirement for Group B for at least the reason that the alleged species identified are not restricted to mutually exclusive characteristics as required by MPEP § 806.04(f). Applicant asserts that a personal communication device that is a Cellular Phone, which is recited in claim 13, is not mutually exclusive of a personal communication device that is a Personal Digital Assistant, which is recited in claim 14. Where a personal communication device functions as both a Cellular Phone and a Personal Digital Assistant, the personal communication device includes both a Cellular Phone and Personal Digital Assistant. *See, also*, Specification, page 14, line 23—page 15, line 13 (describing a communication device that is a PDA and a cell phone).

Applicant traverses the election requirement for Group C for at least the reason that Examiner has not shown an appropriate explanation for such an election. Under 37 CFR 1.141(a), a reasonable number of species may be claimed in one application. However, Examiner has not provided an explanation that a method for authorizing use of a check where the check has a Barcode, a Magnetic Strip, and DIGIMARC (as recited in claims 48, 49, and 50, respectively) are in (A) separate classifications, (B) separate status in the art when they are classified together, or (C) different fields of search, as required by MPEP § 808.02. Nor has Examiner demonstrated that a Barcode, Magnetic Strip, and DIGIMARC constitute more than a reasonable number of species.

Finally, MPEP § 803 requires that “there must be a serious burden on the examiner if restriction is required,” and if the search and examination of an entire application can be made without serious burden, “the examiner must examine it on the merits...” Examiner has not identified the “serious burden” that would result from examining any of the alleged species.

In light of the foregoing, Applicant respectfully submits that the election requirement is inappropriate and requests that it be withdrawn.

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This response is believed to address all issues raised by the Examiner. However, should further issues or questions arise, the Examiner is respectfully requested to contact Chris Hilberg at (612) 607-7386.

Respectfully submitted,

By Christopher R Hilberg
Christopher R. Hilberg, Reg. No. 48,746
Customer No. 34205

Oppenheimer Wolff & Donnelly, LLP
45 South Seventh Street, Suite 3300
Minneapolis, MN 55402-1609
Telephone: 612-607-7386
Facsimile: 612-607-7100
E-mail: CHilberg@oppenheimer.com

OPPENHEIMER

OPPENHEIMER WOLFF & DONNELLY LLP

Plaza VII, Suite 3300
45 South Seventh Street
Minneapolis, MN 55402-1609

oppenheimer.com

612.607.7000
Fax 612.607.7100**RECEIVED**
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April 30, 2004

TO: Examiner James S. McClellan
COMPANY: U.S. Patent and Trademark Office
PHONE:
FAX: 703-872-9306

FROM: Christopher R. Hilberg
DIRECT DIAL: 612.607.7386
EMAIL: Chilberg@Oppenheimer.com
RE: Serial No. 09/714,018
Attorney Docket No. 18822-11

COMMENTS: I certify that this correspondence is being transmitted by facsimile to Examiner James S. McClellan at the U.S. Patent and Trademark Office at facsimile number 703-872-9306 on April 30, 2004.



Ann Pommier

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